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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,988	10/11/2001	Susann Marie Keohane	AUS920010884US1	8102
7590	03/01/2004		EXAMINER	
Mr. Volel Emile P.O. Box 202170 Austin, TX 78720-2170			ROBINSON, GRETA LEE	
			ART-UNIT	PAPER NUMBER
			2177	
			DATE MAILED: 03/01/2004	2

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	09/974,988	KEOHANE ET AL.
	Examiner	Art Unit
	Greta L. Robinson	2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 October 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892) ✓  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-20 are pending in the present application.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, **the first computer system and second computer system** [note independent claims 1, 6, 11 and 16] must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

3. The abstract of the disclosure is objected to because of a typographical error note page 18 line 7 "ufture" should read "future". Correction is required. See MPEP § 608.01(b).

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The formula or function for calculating the predicted download time using the size of the file and historical download time critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Note Applicant makes reference to a cross referencing table figure 3; but is vague as to the function, formula or relationship for calculating the download time [note page 12 lines 25-31].

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 6, 11, and 16 the limitation "caculating the predicted download time using the size of the file and at least a historical download time between the first computer and the second computer system". As stated above, the function, formula or relationship for predicting the download time is vague. Applicant makes a relationship to a cross reference table, but does not appear to define the relationship with respect to a formula or function for downloading. Claims 2-5, 7-10, 12-15 and 17-20 are rejected based on dependency.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valys US Patent 6,549,914 in view of Beyda et al. US Patent 6,505,237 B2.

Regarding claim 1, **Valys** teaches a method of predicting a file download time before said file is being downloaded, said file having a size and being downloaded from a first computer system to a second computer system [note: col. 1 line 66 through col. 2 line 6 "statistically analyzing an overhead or delivery requirement as a function of relevant manufacturing criteria of computer readable files to be downloaded to a target

*computer during a software download"; also note: col. 2 lines 54-61], said method comprising the steps of:*

calculating the predicted download time using the size of the file and at least a historical download time between the first computer system and the second computer system [note: col. 3 lines 8-19 using "historical factory download metrics and files ... to determine which files should be included"; also note: col. 4 lines 15-55; col. 9 lines 38-42]; and

displaying the calculated time [note: col. 9 line 42 through col. 10 line 10].

Although Valys teaches the invention as cited above, he does not explicitly disclose that the download time is based on the size of the file. Beyda et al. teaches this feature.

Beyda et al. teaches a requirement that may be utilized for the downloading of a file is the size of the file [see: col. 2 lines 53-65; col. 6 lines 53-65; and col. 7 lines 16-25; also note figure 3]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Beyda et al. with Valys because Beyda further shows how the filtering conditions for downloading a file may be modified based on user preference, the customized criteria enhances Valys downloading process.

10. Regarding claims 2 and 3, wherein said historical download time is an average time taken to download a plurality of files ... based on an analysis ... [note: Valys, col. 13 lines 28-40 "analysis ... includes history of the downloaded files"].

11. Regarding claims 4 and 5, wherein the predicted download time is calculated by the first computer ... the second computer [note: Beyda et al. attachment filter 42 col. 6 lines 53-65].
12. The limitations of claims 6-20 parallel that of method claims 1-5, therefore they are rejected under the same rationale.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Himmel et al.** US Patent 6,208,995 B1

**LaBiaga et al.** US Patent 6,185,615 B1

**Dujari et al.** US Patent 6,119,153

**Mahajan et al.** US Patent 6,226,650 B1

**Miron** US Patent 6,401,239 B1

**Wong et al.** US Patent 6,654,746 B1

**Beyda et al.** US Patent 6,505,237 B2

**Wells II et al.** US Patent 6,532,495

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**GRETA ROBINSON**  
**PRIMARY EXAMINER**  
Greta Robinson  
Primary Examiner  
February 24, 2004